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APPLICATION NO. 09/464,795	FILING DATE 12/16/99	FIRST NAMED INVENTOR ZHANG	ATTORNEY DOCKET NO. N
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CHARLES K SHOLTZ
XENOGEN CORPORATION
860 ATLANTIC AVE
ALAMEDA CA 94501

HM12/0717

EXAMINER SHUKLA, R

ART UNIT 1632	PAPER NUMBER L
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DATE MAILED:

07/17/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/464,795

Applicant(s)

ZHANG ET AL.

Examiner

Ram R Shukla

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1-64 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

1. Claims 1-64 are pending in the instant application.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-5 and 36-64, drawn to a panel of expression cassettes comprising two or more expression cassettes comprising regulatory elements of different stress-inducible genes, method of making a transgenic animal using the expression cassettes and the method of using the transgenic animals, classified in class 800, subclass 3.
 - II. Claims 6-10, drawn to a panel of expression cassettes comprising two or more expression cassettes comprising regulatory elements of different apoptosis-related genes, classified in class 435, subclass 320.1.
 - III. Claims 11-15, drawn to a panel of expression cassettes comprising two or more expression cassettes comprising regulatory elements of different angiogenesis-related genes, classified in class 435, subclass 320.1.
 - IV. Claims 16-20, drawn to a panel of expression cassettes comprising two or more expression cassettes comprising regulatory elements of different development-related genes, classified in class 435, subclass 320.1.
 - V. Claims 21-25, drawn to a panel of expression cassettes comprising two or more expression cassettes comprising regulatory elements of different oncogenesis-related genes, classified in class 435, subclass 320.1.
 - VI. Claims 26-30, drawn to a panel of expression cassettes comprising two or more expression cassettes comprising regulatory elements of different genes expressed in response to an infection of a host by an infectious agent, classified in class 435, subclass 320.1.

- VII. Claims 31-35, drawn to a panel of expression cassettes comprising two or more expression cassettes comprising regulatory elements of different inflammation-related genes, classified in class 435, subclass 320.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions of the groups I- VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01).

In the instant case the different inventions are drawn to panel of expression cassettes wherein the expression of a reporter gene is driven by the regulatory elements or promoters of genes that have unrelated functions, different site of expression in an animal and their sequence structure and control elements may be different. For example, the promoter of a stress related gene may have different sequence elements and it's regulatory mechanisms of controlling gene expression may be very different from the promoter structure and function of an apoptosis related gene or angiogenesis related gene or development related gene or infection response gene, etc. Additionally, the expression pattern of a development related genes might be restricted to certain stages of development whereas the expression of angiogenesis related genes might be restricted to cells undergoing angiogenesis. Although, the inventions of groups II-VII are all classified in the same class and subclass, they will require independent searches because their search will require the considerations of the name of a particular gene, its expression pattern, presence of sequence elements etc. Therefore, the structure and function of the panels of the expression cassettes of groups I-VII will be patentably distinct each from the other and will require separate searches in the non-patent and patent literature.

3. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art shown by their different classification and their recognized divergent

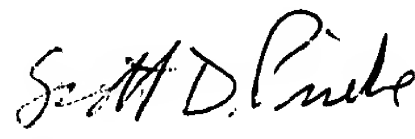
subject matter, and because each invention requires a separate, non-coextensive search, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i). Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ram R. Shukla whose telephone number is (703) 305-1677. The examiner can normally be reached on Monday through Thursday and every other Friday from 8:00 am to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jasmine Chambers, can be reached on (703) 308-2035. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-0196.

Ram R. Shukla, Ph.D.


SCOTT D. PRIEBE, PH.D
PRIMARY EXAMINER